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PERKINS COIE LLP  
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SEATTLE WA 98111-1247

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SEP 16 2009

In re Patent No. 7,539,756 :  
Marchetto et al. :  
Issue Date: May 26, 2009 :  
Application No. 10/062,830 : DECISION ON REQUEST FOR  
Filed: January 31, 2002 : RECONSIDERATION OF  
Attorney Dkt. No. 32052-8005.US : PATENT TERM ADJUSTMENT  
Title: Method and System of :  
Data Packet Transmission Timing :  
For Controlling Bandwidth :  
:

OFFICE OF PETITIONS

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION UNDER 37 C.F.R. §1.705(B)" filed July 27, 2009. This petition is properly treated under 37 CFR 1.705(d). Patentees request that the patent term be adjusted from 322 days to 697 days.

The request for reconsideration of patent term adjustment is DISMISSED.

On May 26, 2009, the above-identified application matured into US Patent No. 7,539,756 with a patent term adjustment of 322 days. This request for reconsideration of patent term adjustment (including the required fee) was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees assert entitlement to a patent term adjustment of 697 days (812 + 515 - 140 (overlap) - 490 (applicant delay)).

Pursuant to 35 U.S.C 154(b)(1)(B), the term of a patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. This period does not include any time consumed by continued examination of the application requested by the applicant under section 132(b). Thus, the relevant period in considering this overlap ends with applicants' filing of the request for continued examination

(RCE) pursuant to section 132(b). Further, the period for over three-year pendency does not include any period of adjustment which overlaps with the period of adjustment for Office delay accorded pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a).

The Office finds that as of the filing of the request for continued examination (RCE) on June 30, 2006, the application was pending three years and 515 days after its filing date. Moreover, as of the filing of the RCE, 736 days of adjustment for Office delay had been accorded pursuant to 35 U.S.C. 154(b)(1)(A) and § 1.702(a)(1).<sup>1</sup> At issue is whether the period of adjustment of 515 days attributable to the Office taking in excess of three years to issue the patent overlaps with the adjustment of 812 days attributable to the Office's failure to issue a first Office action no later than fourteen months after the application filing date.

The Office contends that the 515-day period overlaps. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as

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<sup>1</sup> 76 days of adjustment under § 1.702(a)(4) were accorded subsequent to the filing of the RCE, and thus, are not considered in determining overlap with the 3-year period.

permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

The Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A). The period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap"

under 35 U.S.C. 154(b)(2)(A) is the filing date January 31, 2002 until the filing of the RCE on June 30, 2006. 736 days of adjustment for Office delay were accorded prior to the filing of the RCE. The 515 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 736 days attributable to grounds specified in § 1.702(a)(1) (76 days were accorded subsequent to the filing of the RCE).

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 322 days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney, at (571) 272-3215.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions